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CHARLES ELMORE DROPLEY  
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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1945  
No. 1241

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THE KAR ENGINEERING COMPANY, INC.,  
*Petitioner,*

VS.

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BROWN & SHARPE MANUFACTURING COMPANY and  
JAMES NEILL & Co. (SHEFFIELD), LIMITED,  
*Respondents.*

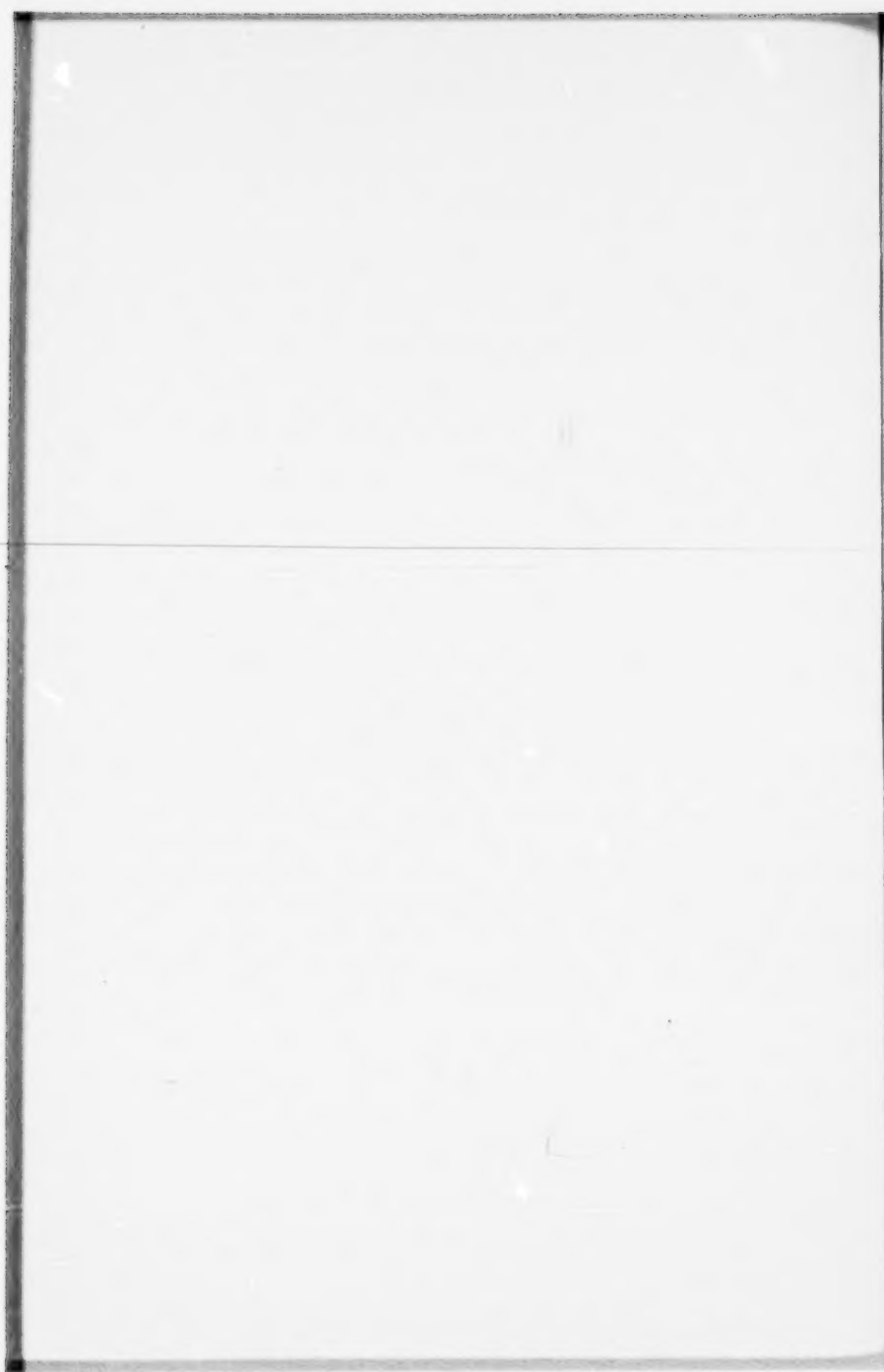
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**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE FIRST CIRCUIT AND BRIEF IN SUPPORT  
THEREOF**

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THOMAS J. BYRNE,  
CLIFFORD H. BYRNES,  
*Counsel for Petitioner.*

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THE KAR ENGINEERING COMPANY, INC.,  
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PANY and JAMES NEILL & Co. (SHEFFIELD),  
LIMITED,

*Respondents.*

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE FIRST CIRCUIT**

*To the Honorable, the Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Petitioner, The Kar Engineering Company, Inc., respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the First Circuit to review the judgment of that court which was entered on the 14th day of March, 1946 (R. 447).

**Summary and Short Statement of  
Matters Involved**

This civil action was brought by respondents Brown & Sharpe Manufacturing Company, a Rhode Island corporation, which has its principal place of business at Provi-

dence, Rhode Island, and James Neill & Co. (Sheffield), Limited, a British Limited Company, against petitioner, The Kar Engineering Company, Inc., a Massachusetts corporation, which has its principal place of business at Great Barrington, Massachusetts (R. 2).

The action was brought for alleged infringement upon letters patent of the United States No. 2,053,177 (R. 155) granted on September 1, 1936 to respondent James Neill & Co. (Sheffield), Limited, as assignee of applicant William Leslie Bower for Work Holder—a chuck in which magnetic articles are held in position by magnetic force. Claims numbered 1, 5, 7 and 14 of the Bower patent are charged to be infringed by petitioner.

Respondent Brown & Sharpe Manufacturing Company is an exclusive licensee under said patent (R. 159, 160).

The District Court of the United States for the District of Massachusetts determined that the Bower patent is invalid as to said claims and directed that the complaint be dismissed (R. 10-21). It did not pass upon the issue of alleged infringement (R. 21).

On appeal of respondents the United States Circuit Court of Appeals for the First Circuit reversed the judgment of the District Court and held said claims of the Bower patent to be valid and also infringed.

A petition for rehearing as to the holding of infringement was presented to the Court of Appeals by petitioner but it was denied without opinion by order entered on April 16, 1946 (R. 447).

The Court of Appeals (a) concluded that this Court has not required a higher standard for invention than was required for a long period of time and sustained the Bower patent which is for a purported improvement within the skill of mechanics in the art, (b) made a ruling as to the issue of infringement and held that infringement exists even though this issue had not been passed upon by the District Court and (c) failed to enforce limitations embodied in claims in suit of the Bower patent during prosecution in the United States Patent Office and accorded an



interpretation of the said claims of the Bower patent which will preclude proper competition and manufacture and sale to the public of permanent magnetic chucks which would have resulted had the limitations in said claims been enforced in deciding the issues of infringement.

### **Jurisdiction to Review Judgment in Question**

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Acts of February 13, 1925 and March 8, 1934 (28 U. S. C. A. § 347) and under 28 U. S. C. A. § 35 for, "within three months" from the date of entry of the judgment, this petition will have been presented.

### **The Questions Presented**

Review of the judgment of the Court of Appeals is sought. The following questions are presented:

1. May the Court of Appeals disregard determination of this Court requiring a high standard for invention for the grant of a valid patent and lawfully sustain a patent for a purported invention which is for an improvement that is clearly within the skill of mechanics in the art?
2. May the Court of Appeals disregard limitations imposed or accepted during the prosecution of an application for a patent in disregard of decisions of this Court and accord scope to claims of a patent without regard to such imposed limitations?
3. May the Court of Appeals pass upon and determine an issue of infringement of claims of a patent when such issue of infringement was not considered, determined or made the basis of findings of fact or conclusions of law by the District Court in which the action was tried.

### Reasons Relied On for the Allowance of the Writ

The discretionary power of this Court is invoked upon the following grounds:

The determination of the Court of Appeals is at variance with the decision of this Court in *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84.

The determination of the Court of Appeals is also contrary to the decisions of the United States Circuit Court of Appeals for the Second Circuit in *Picard v. United Aircraft Corporation*, 128 F. (2d) 632, 636.

The Court of Appeals, because of the divergence of its decision from decision with this Court, determined that the Bower patent is valid but which, according to the law as laid down by this Court, is not properly patentable but is solely for a device which is the result of the skill of mechanics in the art to which it appertains.

The divergence of the decision of the Court of Appeals with the decisions of this Court and of the United States Circuit Court of Appeals for the Second Circuit should be resolved by this Court in the interest of the public.

In determining that claims 1, 5, 7 and 14 of the Bower patent are infringed by petitioner the Court of Appeals did not enforce limitations embodied in said claims during prosecution of the application in the Patent Office, which course is contrary to the law stated by this Court in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, at 443-4, and *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126, at 136-7.

The course of the Court of Appeals in determining the issue of infringement of the Bower patent, which was not decided by the District Court, was improper. It should have remanded the action to the District Court with directions to determine the issue of infringement and to make suitable findings of fact and conclusions of law with

respect thereto. The decision of the Court of Appeals on the issue of infringement resulted in depriving petitioner of its right to have this issue decided by the District Court and reviewed by the Court of Appeals.

The determination of the District Court with respect to validity and infringement of claims 1, 5, 7 and 14 of the Bower patent No. 2,053,177 is contrary to law and will result in preventing manufacture and sale of permanent magnetic chucks and fair and lawful competition therein.

WHEREFORE, it is respectfully submitted that this petition for a writ of certiorari should be granted.

THOMAS J. BYRNE,  
CLIFFORD H. BYRNES,  
*Counsel for Petitioner.*

Dated, May 17, 1946.



## BRIEF IN SUPPORT OF PETITION

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### Opinions in the Action

The decision of the District Court (R. 10-21) is reported in 59 F. Supp. 820 and the opinion of the Court of Appeals (R. 431-46) is reported in 154 F. (2d) 48.

### Jurisdiction

The opinion (R. 431) and the judgment (R. 447) of the Court of Appeals were filed and entered on March 14, 1946.

A petition for rehearing as to the issue of infringement was filed by petitioner on March 28, 1946 and an order denying this petition was entered on April 16, 1946 (R. 447).

The statute which accorded jurisdiction is Section 240 (a) of the Judicial Code (28 U. S. C. A. § 347).

Decisions of this Court which are believed to sustain jurisdiction follow:

*Mackay Radio & Telegraph Co. v. Radio Corporation of America*, 306 U. S. 86, at 89.

*Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, at 546.

*Carbice Corporation of America v. American Patents Development Corporation*, 283 U. S. 27.

*De Forest Radio Co. v. General Electric Co.*, 283 U. S. 664.

*Muncie Gear Works, Inc., et al. v. Outboard Marine & Mfg. Co., et al.*, 315 U. S. 759.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47.

*Sinclair & Carroll Co., Inc. v. Inter-Chemical Corp.*, 325 U. S. 327.

### Statement of the Case

The foregoing petition contains a summary of some of the material facts necessary to an understanding of the reasons relied upon for the allowance of the petition.

The Bower patent (R. 155), for a permanent magnetic chuck, may be understood from Figs. 2 and 2<sup>a</sup> of its drawings. The permanent magnets 1 are of W-shape and each magnet has three poles. The permanent magnets are housed in a casing 4. A face plate 3 is provided for the casing 4. Pole pieces 2 are cast in the face plate 3 which supports the work piece. When the permanent magnets 1 are in the position shown in Fig. 1 the pole pieces 2 contact with the magnets 1 and admit of magnetic flux passing through a work piece placed upon the plate 3.

When the magnets 1 are moved to the right, as shown in Fig. 2<sup>a</sup>, the pole pieces 2 remain in contact with the magnets 1 but the pole pieces 2 bridge the gaps between adjacent poles of the magnets 1. When in this position almost all of the magnetic flux passes through the pole pieces 2 and only a very small amount passes through the work piece. This is to shunt the flux from the work piece.

When in the off position, Fig. 2<sup>a</sup>, the face plate 3 may not be lifted off for the reason that flux passes through the pole pieces 2 and this prevents its removal.

Defendant's device is shown in Exhibit H (R. 364) in the "off" and "on" positions. It is also shown in Exhibit N (R. 425) and Exhibit S (R. 426). It comprises an assembly of permanent magnets. At their upper ends the magnets terminate in tapered soft metal. Alternating with the magnets are conducting bars of soft metal. The conductor bars are narrower than the magnets. The magnets and conductor bars are enclosed in a casing. The plate comprising the base of the casing, together with the magnets and conductor bars, form a path for the magnetic flux (R. 121). The face plate is made of aluminum, a non-conductor of magnetism. A series of conductor bars or pole pieces are arranged in slots in the face plate.

When defendant's chuck is in the "on" position the bottoms of the several pole pieces in the face plate are in register with the tops of the magnets and the conductor bars (Exhibit H, R. 364).

In the "off" position the bottoms of the pole pieces are positioned between the upper ends of the magnets and conductor bars. An air space exists between the magnets and the conductor bars. No shunt for the flux is provided by petitioner. There is no metallic or other path provided for the flux as in the Bower device. The well known horseshoe permanent magnet is all that is present in the "off" position of petitioner's device for the flux passes from a magnet across an air space to the conductor bar and base completing the magnetic circuit.

The face plate, including the pole pieces, may be removed when petitioner's chuck is in the "off" position. This is because little flux passes to the pole pieces.

Electromagnetic chucks and permanent magnetic chucks and their operation were old and well known prior to Bower (finding 9, R. 11). Permanent magnets were used but "they would become weak" (R. 105). The art awaited a suitable metal. Such metal was produced but not by Bower. It was known by the name "Alnico" (R. 105). It is a ferrous alloy containing aluminum, nickel, cobalt and iron. With the advent of Alnico permanent magnets could be safely used. Respondents confirm the fact in their leaflet (Exhibit F; R. 325) in which they state:

"The magnets of a special alloy are many times stronger than magnets previously available and last indefinitely. The chuck has strong holding power, adapting it for grinding operations and, also, for light cuts on lathe work and other machine operations."

Petitioner in its catalog (Exhibit 17; R. 210-11) states:

"The recent development of special alloys having *permanent* magnetic properties to a very high degree, has made possible the modern permanent magnetic chuck. \* \* \*

“ \* \* \* Recent developments in magnetic alloys have made possible the production of permanent magnets of great power and retentivity, thus permitting the use of permanent magnet devices of unusual utility and simplicity.”

The Court of Appeals did not mention the development of suitable magnetic alloy which made possible the “production of permanent magnets of great power and retentivity”.

When the suitable alloy was produced it was the work of a mechanic to use it in a permanent magnet.

Varley prior patent (R. 332) of 1906 shows a circuit controller in which a permanent magnet is employed.

Hanson patent (R. 338) of 1911 shows an electromagnetic chuck with alternate north and south poles. They are separated by narrow non-magnetic material. The face plate is movable and it has separate pole pieces of high permeability magnetic material separated by narrow pieces of non-magnetic material. Each of the pole pieces registers with one of the several poles of the magnet. Movement of the movable pole piece results in making or breaking of contact between the magnets and pole pieces. There is a striking analogy between Hanson and the Bower patent. In Fig. 2 of Bower the pole pieces 2 are separated by narrow magnetic strips 3.

Bing patent (R. 348) of 1929 shows an electromagnetic chuck. It is circular in form but the same construction may be used in a rectangular form. A holding or face plate 1 is placed above cores 8. Rings 10 of magnetizable material are provided in the face plate 1—one ring for each of the three magnets 8. The rings 10 are in reality separate pole pieces. In Bing electric current may be on at all times and for removing work pieces from plate 1 the plate is moved with respect to magnets 8 so that the work piece is brought to a position in a neutral zone where the flux is neutralized and the work may be removed.

Edwards British patent (R. 352) is for an engineer's T square and drawing board. A permanent magnet 10 is



provided to hold the T square in close association with the edge of the drawing board. In order to release or modify the grip of the magnetism on the held piece, Edwards uses a magnetic shunt to perform the same function that Bower performs. The permanent magnet 10 will contact and hold the metal strip 14. Edwards provides means to shunt the flux of the permanent magnet out of the strip 14—the work piece.

The Court of Appeals stated (R. 442-3) that Edwards is concerned with “comparatively weak magnetic forces”, that for all that appears Edwards was only “a paper patent” and that Edwards is in “an art far removed from chucks”. It is not material whether or not a prior patent has been used or is a so-called paper patent. It is, nevertheless, pertinent for what it shows. It is idle to consider a drawing board and T square remote from any mechanical or electrical equipment. Drawings boards and T squares are always found in machine shops where devices, machinery and equipment are laid out on drawing boards before construction is begun.

### Specification of Errors

1. The Court of Appeals erred in that it did not apply the decision of this Court which requires a high standard of invention for the grant of a valid patent (enunciated in full effect in the *Cuno Engineering Corp. v. The Automatic Devices Corp.*, 314 U. S. 84) and in sustaining the Bower patent in suit for a purported invention since it is merely for an improvement that is clearly within the skill of mechanics in the art.

2. The Court of Appeals erred in not applying the decisions of this Court (*I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, at 443-4, and *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126, at 136-7) which require that limitations embodied in the claims of the Bower patent in suit during prosecution of the application

therefor in the Patent Office, and in according scope to claims of the Bower patent in suit without regard to the limitations imposed therein during the prosecution of the application for the Bower patent.

3. The Court of Appeals erred in determining the issue of infringement when such issue had not been determined by the District Court and in that it did not remand the action to the District Court with directions to determine said issue.

## ARGUMENT

### POINT I

The decision of the Court of Appeals (R. 431-46) is in conflict with the decisions of this Court and with decisions of the United States Circuit Court of Appeals for the Second Circuit. All lower Federal Courts and the public would be aided by a determination of the conflict of decisions by this Court.

The Court of Appeals recognized that a higher standard for invention is required. This is evidenced by its decisions in *Anderson Co. v. Lion Products Co.*, 127 F. (2d) 454, 457, and *Bellavance v. Frank Morrow Co.*, 140 F. (2d) 419, 423.\* It stated that it is presented "with the question whether the Supreme Court in the *Cuno* case \*\* intended

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\* In the *Bellavance* case the Court of Appeals received and considered a motion to reconsider its denial of plaintiff's petition for rehearing. The motion to reconsider was tendered in view of the decision in *Goodyear Tire & Rubber Co., et al. v. Ray-O-Vac Co.*, 321 U. S. 275. The Court of Appeals stated in its opinion that it was urged that the decision of the *Goodyear* case "in practical effect" overruled the *Cuno* case and the trend of the Supreme Court "toward an ever stricter application of the invention". The motion to reconsider the petition for rehearing was denied—141 F. (2d) 378. Thereafter this Court denied a petition for certiorari—322 U. S. 742.

\*\* *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84.

to establish for the future a new and higher standard of invention than had prevailed in the past" and it overruled its prior decisions in the said *Anderson* and *Bellavance* cases and held that this Court did not by the *Cuno* decision require a higher standard for invention. The decision of the Court of Appeals is at variance with the decision of this Court in the *Cuno* case as to standard of invention.

In the *Cuno* case this Court said that "the functions performed by Mead's combination were new and useful", that "Ingenuity was required to effect the adaptation" but that the fact that Mead's device was new and useful "does not necessarily make the device patentable" and that the ingenious adaptation was "no more than that to be expected of a mechanic skilled in the art". It is inherent in the decision of this Court in the *Cuno* case that a high standard for invention was laid down.

In *Picard v. United Aircraft Corporation*, 128 F. (2d) 632, the Court of Appeals for the Second Circuit had before it a patent for a lubricating system for a radial air-cooled aircraft combustion engine. The Court of Appeals said that the inventor's "disclosure was indubitably an improvement—deserves to be called inventions" but (p. 636)

"We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow not to resist'."

The Schenk patent was held to be invalid for lack of invention.

This Court denied a petition for writ of certiorari—317 U. S. 651.

This Court and the Court of Appeals for the Second Circuit are in accord that the standard for invention is higher than in the past.

The Court of Appeals in the case at bar flatly states that this Court in the *Cuno* case does not require a higher

standard for invention than in the past. The Court of Appeals will not require a higher standard for invention while this Court and the Court of Appeals for the Second Circuit will require a higher standard for invention. Complexity, difficulty and loss of property will result from the divergence of application of the rule of this Court. Consequently, it would be in the interest of the public to have the divergence of application of the law resolved by this Court.

## POINT II

The decision of the Court of Appeals (R. 431-46) is in conflict with the decisions of this Court which require that limitations embodied in claims of a patent during its application stage must be considered and given effect in construing claims and when determining whether or not they are infringed.

During the prosecution of the application for the Bower patent the claims in issue, Nos. 1, 5, 7 and 14, were amended in view of the citation of prior patents by the Patent Office. Claim 1 was amended to provide for means operable at will for establishing "an auxiliary circuit to shunt the field out of the work". Claim 5 was amended to include "means \* \* \* to shunt said flux". Claim 7 was amended to include "means \* \* \* to establish an auxiliary circuit to cause magnetic flux to be diverted" and claim 14 was amended to include "means \* \* \* to establish an auxiliary circuit for shunting the field out of the work".

Petitioner's device is shown in the drawing (Exhibit S; R. 426). It is seen therefrom that petitioner does not have an auxiliary circuit to shunt the field out of the work or for diverting the magnetic flux. In the "off" position of its chuck no "means"—a shunt or other circuit—is provided.

The Court of Appeals in construing claims 1, 5, 7 and 14 of the Bower patent did not heed the limitations embodied therein to avoid prior patents when in the application stage and would not accord to said claims "a narrow range of

equivalents", but accorded more generous treatment because "of the practical value and importance of the patentee's contribution" (R. 446). The limitations injected in the Patent Office were not enforced.

In *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502, this Court said (p. 510):

"The scope of every patent is limited to the invention described in the claims contained in it read in the light of the specification."

The claim of a patent is the measure of the patentee's right to relief. What is not covered by a claim is open to the public.

*McClain v. Ortmyer*, 141 U. S. 419, 424.

It is unjust to the public and an evasion of the law to construe a claim in a manner different from the plain import of its terms.

*White v. Dunbar*, 119 U. S. 47, at 52.

In the device of the defendant, when in the off position, it does not have an auxiliary circuit to shunt the field out of the work or means to establish an auxiliary circuit for diverting magnetic flux called for by claims 1, 5, 7 and 14. When in the off position petitioner's chuck has an air space between the magnetic poles and the pole pieces. The magnetic flux is left free to travel where it will. In its off position petitioner's device is precisely the same as Fig. 1 of Exhibit 5 (R. 175). Fig. 1 of Exhibit 5 is "exactly similar to a well-known horseshoe magnet" (R. 30). The determination of the Court of Appeals as to the issue of alleged infringement of claims 1, 5, 7 and 14 of the Bower patent is opposed to the decisions of this Court in:

*I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, at 443-4.

*Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, at 136, 137.

The rule is stated in these decisions that whether or not the Patent Office was right or wrong in rejecting a claim in an application where an amendment is made which includes limitations the patentee is bound thereby, the public is entitled to rely upon the limitations and an interpretation of such claims when they mature in a patent may not be accorded scope to cover that which was excluded by the limitations embodied in order to obtain the patent.

The decision of the Court of Appeals on the issue of infringement is contrary to the decisions of this Court referred to. The interpretation accorded by the Court of Appeals to claims Nos. 1, 5, 7 and 14 of the Bower patent will result in injury to the public for it will preclude proper manufacture and sale of permanent magnetic chucks by manufacturers since they may not rely upon the limitations included in the said claims of the Bower patent. Proper competition will be precluded with loss and injury to the public unless corrected.

### POINT III

The Court of Appeals determined the issue of infringement of claims 1, 5, 7 and 14 of the Bower patent even though the District Court had not considered and determined the issue of infringement of said claims and had not made findings of fact or conclusions of law with respect thereto.

Rule 52 of the Rules of Civil Procedure for the District Courts of the United States requires that in all actions tried upon the facts without a jury "the Court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment".

The District Court did not determine the issue of infringement doubtless for the reason that it held the Bower patent to be invalid.

Neither the Court of Appeals nor the litigants had the benefit of consideration of findings of fact or conclusions

of law as to alleged infringement by defendant upon claims 1, 5, 7 and 14 of the Bower patent. A petition for rehearing was presented to the Court of Appeals as to its decision on the issue of infringement, but the petition was denied without opinion (R. 447).

The District Court directed (R. 21) an "appropriate decree in conformity with these findings and conclusions". All of them related to the invalidity of the Bower patent.

The function of appellate courts is to review judgments and the findings of the trial court relating thereto, and not to pass upon evidence *de novo*.

*Webb v. Frisch et al.*, 111 F. (2d) 887 (C. C. A., Seventh Circuit).

In *Hazeltine Corporation v. Crosley Corporation*, 130 F. (2d) 344, the Court of Appeals for the Sixth Circuit had before it an appeal in a patent suit in which the complaint was dismissed on the ground of non-infringement. No "opinion was expressed, no findings of facts were filed, and no conclusions of law were stated by the district court with respect to the validity of the patent claims in issue" (p. 349). Appellant urged that the issue of validity be passed upon, but the Court concluded that it "cannot agree that such a procedure would be appropriate" (p. 349). The Court of Appeals, the reviewing court, would not adjudicate the issue of validity of the patent which had not been the subject of findings of the trial court.

In *Mayo, Commissioner of Agriculture of Florida v. Lakeland Highlands Canning Co. et al.*, 309 U. S. 310, this Court had before it an appeal from an award of an interlocutory injunction. A law of a state was held to be unconstitutional. Reversal was directed by this Court with instructions that if the interlocutory injunction is pressed, any action thereon "shall be upon findings of fact and conclusions founded upon the evidence, in accordance with Rule 52 (a) of the Rules of Civil Procedure".



In *Kelley et al. v. Everglades Drainage District*, 319 U. S. 415, this Court pointed out that (pp. 421-2) "it is not the function of this Court to search the record and analyze the evidence in order to supply findings which the trial court failed to make" and that "there must be findings, stated either in the court's opinion or separately, which are sufficient to indicate the factual basis for the ultimate conclusion" (p. 422).

In *City of Sumter et al. v. Spur Distributing Co.*, 110 F. (2d) 649 (C. C. A., Fourth Circuit), the appeal was from an order granting an interlocutory injunction. There were no findings of fact as required by Rule 52. The action was remanded "for further findings in accordance with a requirement of Rule 52 (a)".

The Court of Appeals should have remanded the issue of infringement of the Bower patent to the District Court to determine and make findings of fact and conclusions of law with respect thereto.

### CONCLUSION

**It is submitted that the petition for writ of certiorari should be granted.**

THOMAS J. BYRNE,  
CLIFFORD H. BYRNES,  
*Counsel for Petitioner.*

Dated, May 17, 1946.



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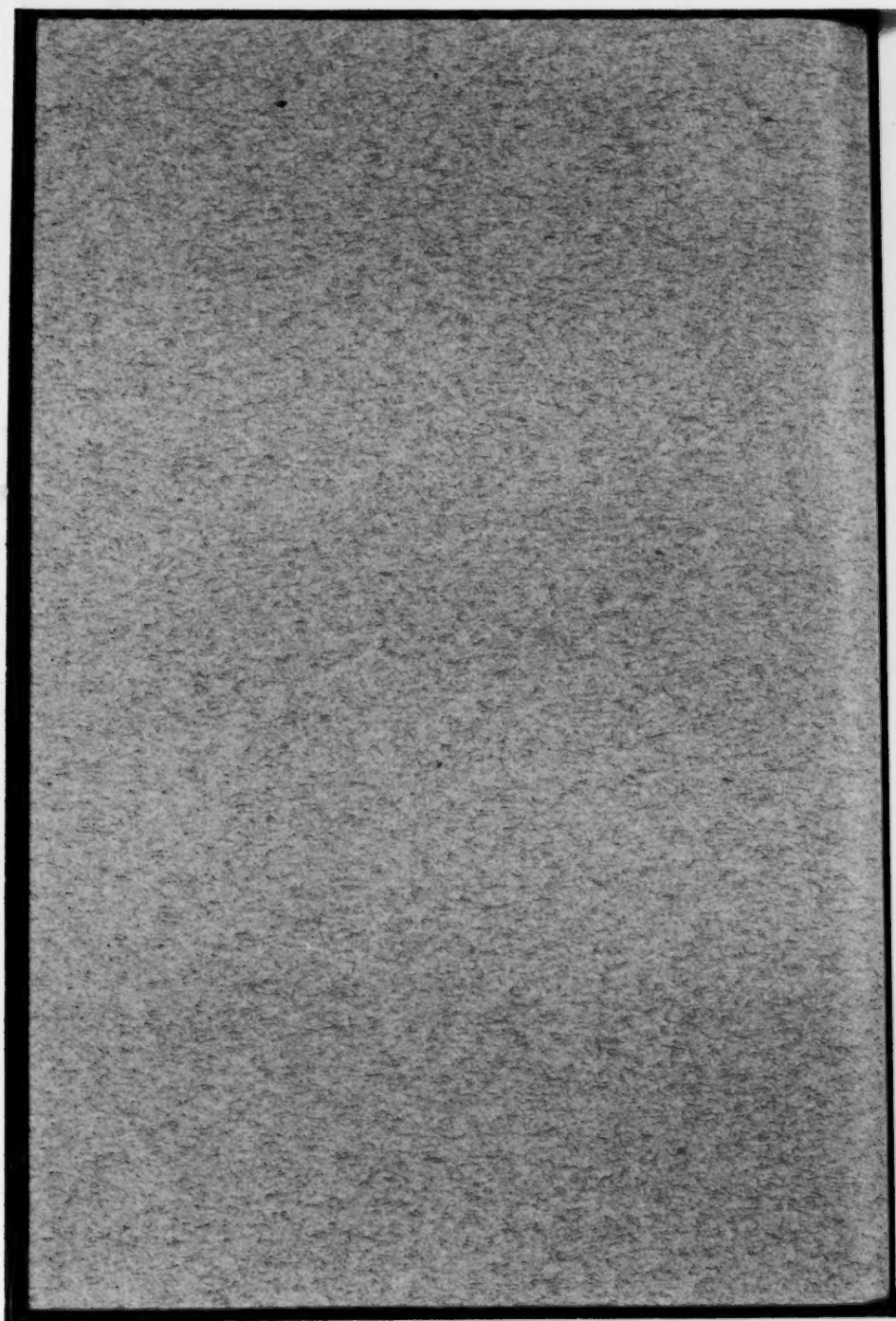
**Respondents.**

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**BRIEF FOR RESPONDENTS IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

—  
**HECTOR M. HOLMES,**

**MAXWELL FISH,**

*Counsel for Respondents.*

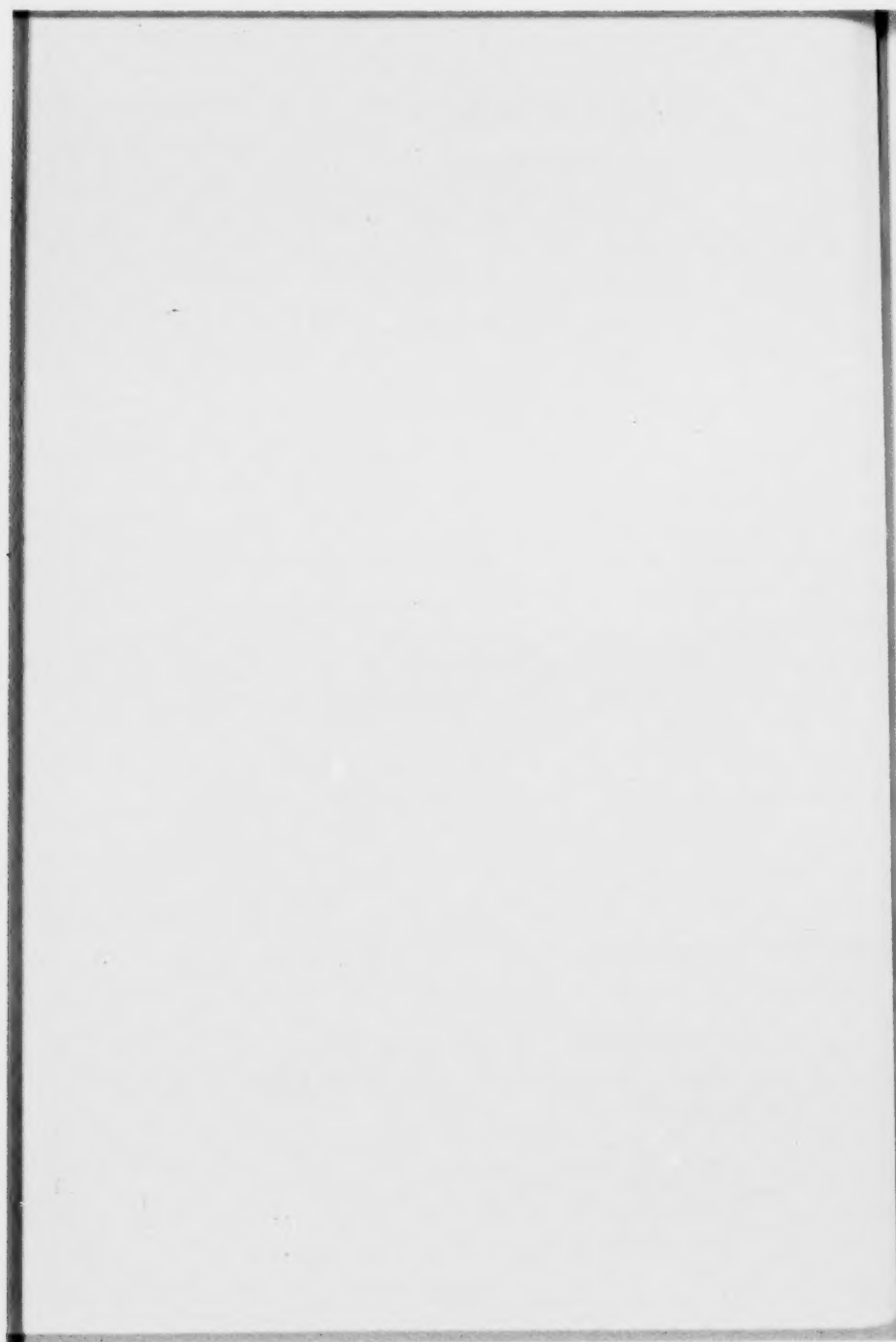


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**In the  
Supreme Court of the United States.**

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**OCTOBER TERM, 1945.**

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**No. 1241.**

**THE KAR ENGINEERING COMPANY, INC.,  
PETITIONER,**

*v.*

**BROWN & SHARPE MANUFACTURING COMPANY  
AND JAMES NEILL & CO. (SHEFFIELD), LIMITED,  
RESPONDENTS.**

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**BRIEF FOR RESPONDENTS IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

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This is an ordinary patent suit involving no conflict of decisions between different Courts of Appeal, no new or doubtful question of law, no conflict between the decision of the Court of Appeals and applicable decisions of this Court or any other court, and no matter of public importance.

Petitioner argues with equal emphasis three assignments of error as supplying the "special or important" reasons for granting the writ. The essential facts of the case are adequately stated in the findings of the District Court and the opinion of the Court of Appeals and we will confine this brief to a consideration of the three assignments of error in the order of their presentation by petitioner.

## I.

## ALLEGED ERROR AS TO INVENTION.

There is here merely a very common question of fact in patent cases, that is, whether under all the circumstances of the case, what the patentee did amounted to invention or was merely something that was within the skill of the art measured by the high standards now obtaining.

Petitioner attempts to procure a further consideration of this issue of fact by erroneously asserting that the Court of Appeals has failed to recognize any higher standard of invention than existed years ago and in so doing has held patentable that which is within the skill of the art. The facts are to the contrary.

The Court of Appeals adopted as its guide the classic test of "a long line of cases" as specifically affirmed in the case of *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U.S. 327, in which this Court made the clarifying pronouncement quoted by the Court of Appeals (R. p. 441), subsequent to the decision of the District Court in the present case. While petitioner contends that the present decision is at variance with the decision in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, no contention is or can be made that the decision is at variance with the principles set forth in the later *Sinclair* case, which is nowhere mentioned by petitioner except in the list of decisions cited to sustain jurisdiction (Pet., p. 7).

The Court of Appeals, while following the *Sinclair* decision that there is no *new* test, subjective or objective, specifically recognized that the standard of skill and capacity "is far higher" now than formerly, that many improvements accorded patentability in the past would and should not now be sustained, and that "more must now be done to qualify for the title of 'inventor' than formerly was required" (R. pp. 441-442).



Viewing the impressive facts of the case, as found by the District Court, in the light of these "far higher" standards, and while bearing in mind that Bower made his invention in "an art not only crowded but also one in which skills are well known to be high" (R. p. 443), the Court of Appeals found as a fact that the invention of the Bower claims in issue is clearly patentable as showing ingenuity beyond the capacity of the man skilled in the art, in creating his device which is "a substantial innovation" for which "society is truly indebted to Bower".

In view of the pronouncement of the *Sinclair* decision, followed by the Court of Appeals, and in view of the clear recognition by that court of the "far higher" standards to be invoked,\* it cannot be said that the decision is at variance with the decisions of this or any other court.

Moreover, the District Court and the Court of Appeals were in agreement that (1) Bower's creation was novel, (2) his "accomplishment" was a substantial innovation, for which the art is indebted to Bower, (3) any present idea or *a priori* conclusion (hindsight or "retrospective simplicity")\*\* that Bower's accomplishment is an "obvious" one, within the capacity of the "skilled craftsman", "disregards the history of chucks", (4) Bower's accomplishment arose in an old, crowded, active\*\*\* and highly skilled art, and

\* The "doctrinal trend" referred to in *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 637. Incidentally, the petition (p. 13) in quoting the opinion in the *Picard* case as stating that the inventor's "disclosure was indubitably an improvement—deserves to be called inventions" makes an incomplete quotation which completely distorts the court's statement (p. 636) which was as follows: "It is always troublesome to know what improvements—for Schenk's disclosure was indubitably an improvement—deserve to be called inventions."

\*\* *Universal Oil Co. v. Globe Co.*, 322 U.S. 471, 486.

\*\*\* A United States patent for a magnetic chuck issued as early as 1875 (Ex. 24, R. p. 218). The main inventive activity in the art commenced in 1898 and up to August, 1934, with particular activity in the years from 1920 on, some 76 patents for magnetic chucks issued

solved a problem that appeared insuperable, (5) his new chuck, the first to solve the problem of practical utilization of permanent magnets in a chuck with all the advantages thereof, was greeted by the trade "with astonishment and enthusiasm at its simplicity" and satisfied a felt need as manifested by an immediate commercial success that was "impressive" and due to the merit of the improvement.

We therefore have concurrent findings, not challenged by petitioner, which furnish the strongest kind of evidence that as a matter of fact Bower's improvement involved invention. The facts and circumstances found concurrently by the two courts and on which the Court of Appeals relied, constitute to a most unusual degree those "factors" which this Court, in *Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, held "were entitled to weight" in determining invention, citing with approval, by page number references, a long line of statements of this Court rendered over the years, statements therefore which have not been overruled or abrogated.

The decision of the Court of Appeals is not at variance but is in complete accord with the principles so recently approved by this Court.

Petitioner makes no contention that the *Cuno* case or any other case or line of cases is controlling on the facts. In the *Cuno* case the patentee, Meade, claimed as invention the use of the old thermostat in an old type of cigar lighter instead of in an electric iron or other device, the thermostat operating in the same old way and for the same purpose—

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to 35 United States and foreign patentees, including the president of the defendant company. With all this striving for better and improved magnetic chucks, no one until Bower succeeded in finding a way to utilize permanent magnets instead of electro-magnets. Hanson in 1911 (R. p. 339, line 20) said that permanent magnets might conceivably be used but, as the lower court pointed out (R. p. 16), "Nothing in Hanson shows how to release the work if the magnet instead of being an electro-magnet is a permanent magnet."

a mere double use. Meade sought to monopolize any use of a thermostat in a cigar lighter. His particular method of application was unsuccessful and never used. This Court enunciated no new principle in holding such a mere double use unpatentable but stated the established principles of the familiar double use cases which clearly applied. There is no question of double use in the present case, and petitioner makes no contention that there is.

On no score can it be said that the decision in the present case is at variance with any applicable decision of this Court or any other court.

[While petitioner does not list it as a reason for allowance of the writ, petitioner repeats a contention advanced before the Court of Appeals, that prior to Bower the art did not succeed in making a successful permanent magnet chuck because existing magnet materials were not adequate and the art had to await the advent of Alnico, which came in the middle 30's. The statements of the petition in this regard are untrue.\* The art did not, and did not have to, await the advent of Alnico for a practical permanent magnet chuck. The art had to await the Bower invention.]

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\* The fact is, when Bower, engineer of plaintiff Neill & Co., successfully developed and commercialized his invention in England, Alnico was not known in England or to Bower (R. pp. 228; 224). In his development and first commercial exploitation, Bower successfully used the old and well known permanent magnet material, cobalt steel (referred to by the Court of Appeals, R. p. 434), which is just as good as Alnico (R. pp. 226, 434), and which had been in general use for permanent magnets in England since 1919 (Ex. 29, pp. 307-308) and the patents for which issued in this country in 1920 (R. pp. 300-306 and Ex. 27, R. pp. 295-299). When Alnico became known after Bower's commercial exploitation had started, Neill used it along with a Nifal metal, because they are less expensive than cobalt steel (R. p. 225). As to the situation prior to 1919, there is no evidence in the record except an indefinite and uncorroborated suggestion of petitioner's witness, Hughes, (R. p. 108), that in 1911 and earlier, permanent magnets of sufficient pull were not available.

## II.

**ALLEGED FILEWRAPPER ESTOPPEL.**

Petitioner further assigns as error disregard of the Court of Appeals, in finding infringement, of alleged limitations imposed on the claims in the Patent Office—the familiar file wrapper estoppel argument. This contention was urged before the Court of Appeals, but found “too unsubstantial to warrant discussion” (R. p. 446). In its petition for rehearing, petitioner did not ask for rehearing on this question.

Petitioner’s argument on this point is founded on the erroneous proposition that while its chuck has Bower’s new organization of pole pieces and permanent magnet elements, relatively movable, it “does not have an auxiliary circuit to shunt the field out of the work or for diverting the magnetic flux” (Pet., p. 14). The facts are to the contrary, as the Court of Appeals found.

“In both chucks, then, there is a ‘shunting’ of the flux, to use the terminology of the patent, through an ‘auxiliary’ circuit, the only difference between the chucks being in the nature of this circuit. From this, as we see it, infringement necessarily follows unless the claims in suit are limited to a complete all metallic bridge as a shunt.” (R., pp. 445–446.)

The Court’s finding that the claims in suit are not limited to an all metallic shunt circuit (R. p. 446) is not disputed by petitioner. The language of the amendments which petitioner relies on does not purport to limit the claims to a circuit which is all metal as distinguished from one partly through air and there was nothing in the prior art to have required such a limitation.

The familiar file wrapper estoppel cases cited by petitioner are therefore not in point and the assignment is without merit.

## III.

## ALLEGED ERROR IN PASSING ON INFRINGEMENT.

Petitioner asks that the writ be granted because the Court of Appeals should have returned the case to the District Court for a finding as to infringement, although all the necessary evidence was before the Court of Appeals, there was no controversial issue of fact, and the court deemed the issue so clear that "no other conclusion can reasonably be reached" (R. p. 443). Petitioner joined with respondents in asking the Court of Appeals to decide the issue of infringement, and petitioned for rehearing, not on the ground that the Court of Appeals was in error in passing upon the issue, but on the ground that the court should have found noninfringement. Petitioner has waived any right to now complain. Moreover, even without waiver, on principle and precedent, the Court of Appeals was warranted in exercising its discretion under these circumstances.

The cases cited by petitioner are not in point, and are either incompletely or erroneously abstracted by petitioner. None of them purports to hold that findings of fact by the lower court are a jurisdictional requirement on appeal.

Findings of fact by the lower court are not a jurisdictional requirement on appeal.

It has been common and universal practice, both before and since the present rules, for appellate courts, in their discretion, to decide issues not passed on or the subject of findings by the district court where, as here, there is no dispute on the facts and all necessary evidence is before the court. See for instance,—

*Six Wheel Corp. v. Sterling etc. Co.*, 50 F. (2d) 568 (C.C.A. 9th);

*Fahrenwald v. Republic Iron & Steel Co.*, 61 F. (2d) 385, 386 (C.C.A. 3d);

*Horvath v. McCord Radiator & Mfg. Co.*, 100 F. (2d) 326, 333 (C.C.A. 6th);  
*Vallen v. Volland*, 122 F. (2d) 175, 177 (C.C.A. 8th);  
*Pevely Dairy Co. v. Borden Co.*, 123 F. (2d) 17, 20 (C.C.A. 9th);  
*Thomas v. Simmons Co.*, 126 F. (2d) 743 (C.C.A. 7th);  
*Marchus v. Druge*, 136 F. (2d) 602, 605 (C.C.A. 9th);  
*Hurwitz v. Hurwitz*, 136 F. (2d) 796, 799 (App. D.C.);  
*Sbicca-Del Mac v. Milius Shoe Co.*, 145 F. (2d) 389, 400 (C.C.A. 8);  
*Burman v. Lenkin Const. Co.*, 149 F. (2d) 827, 828 (C.A.D.C.);  
*Schering Corp. v. Gilbert*, 153 F. (2d) 428, 433 (C.C.A. 2d);  
*Denver v. Denver Union Water Co.*, 246 U.S. 178, 182;  
*Philippine Sugar etc. Co. v. Philippine Islands*, 247 U.S. 385, 391.

Respectfully submitted,

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 MAXWELL FISH,

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